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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 11/14/2003

41

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/145,987

Applicant(s)

NAKANISHI ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-18, 20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-18, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1623

DETAILED ACTION

1. The amendment filed August 27, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claims 24 and 25 have been added;
 - (B) Claims 17, 18 and 22 have been amended;
 - (C) Claims 14, 19 and 21 were previously canceled;
 - (D) Comments regarding Office Action have been provided drawn to:
 - (i) 112, 2nd paragraph rejection, which has been maintained;
 - (ii) 102(b) rejection, which has been withdrawn;
 - (iii) 103(a) rejection, which has been withdrawn.
2. Claims 1-13, 15-18, 20 and 22-25 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

Election by Original Presentation

4. Newly submitted Claims 24 and 25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The Inventions as originally filed which include claims directed to cellulose triacetate compound and the invention of Claims 24 and 25 which is directed to a film comprising the cellulose triacetate compound are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful for preparing fibers and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds

Art Unit: 1623

one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 24 and 25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

5. Claims 1-13, 15-18, 20, 22, and 23 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons set forth on pages 2 and 3 of the Office Action mailed April 28, 2003.

Response to Arguments to 35 USC § 112, 2nd Paragraph Rejection

6. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection of the claims under 35 U.S.C. 112 by suggesting advancing the prosecution of the application by using terminology "cellulose triacetate derivative" to distinguish from the Sullivan reference by the phrase "with a reactant consisting essentially of acetic anhydride". The Examiner is of the opinion that the phrase "with a reactant consisting essentially of acetic anhydride" would not overcome the Sullivan reference since said phrase is a process limitation.

Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Accordingly, the rejection of Claims 1-13, 15-18, 20, 22, and 23 under 35 U.S.C. 112, second paragraph is maintained for the reasons of record.

Claim Rejections - 35 USC § 102

7. Claims 1-10, 13,15, and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Finlayson (GB Patent No. 1,102,976) for the reasons set forth on pages 3 and 4 of the Office Action mailed April 28, 2003.

Response to Arguments Against Finlayson under 35 USC § 102

8. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Finlayson patent is silent on the role of a free carboxyl groups in cellulose triacetate. This argument is not persuasive since the present of a free carboxyl group is only one of the features optionally required for the instantly claimed cellulose triacetate compound. Features (ii) and (iii) are limited to process conditions. See page 2, 1st column, lines 7 and 34 of the Finlayson patent wherein perchloric acid and acetic acid may be present with the cellulose triacetate which are acids that fall within the group consisting of an acid having an acid dissociation exponent pKa of 1.93 to 4.50 set forth in feature (ii) of instant Claim 1. Process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Arguments directed to unexpected advantages and commercial success to show differences between the cellulose triacetate of the instant claims and the cellulose triacetate of the Finlayson patent are noted. However, Applicants are reminded that a difference in intended use cannot render a claimed composition novel. Note *In re Tuominen*, 213 USPQ 89 (CCPA, 1982); *In re Pearson*, 494 F2d 1399; 181 USPQ 641 (CCPA, 1974); and *In re Hack* 114 USPQ 161. Accordingly, the rejection of Claims 1-10, 13,15, and 16 under 35 U.S.C. 102(b) as being anticipated by the Finlayson patent is maintained for the reasons of record.

Art Unit: 1623

9. Claims 1 and 4-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (US Patent No. 4,426,481) for the reasons set forth on page 4 of the Office Action mailed April 28, 2003.

Response to Arguments Against Sullivan under 35 USC § 102

10. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground by indicating that specifying in the claims that the acetic anhydride reactant consists essentially of acetic anhydride excludes polybasic acids such as the dibasic and tribasic acids of the Sullivan patent. This argument is not persuasive since reference to the acetic anhydride reactant consisting essentially of acetic anhydride refers to a process limitation. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), *supra*; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Applicants argue that there are significant differences in function between the carboxyl groups of dibasic acid half-esters of cellulose as in Sullivan and carboxyl groups of cellulose triacetate as claimed herein. This argument is not persuasive since the argument is based on how the products are being used. As indicated above, a difference in intended use cannot render a claimed composition novel. Accordingly, the rejection of Claims 1 and 4-10 under 35 U.S.C. 102(b) as being anticipated by the Sullivan patent is maintained for the reasons of record.

11. Claims 1 and 4-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al (US Patent No. 3,816,150) for the reasons set forth on pages 4 and 5 of the Office Action mailed April 28, 2003.

Response to Arguments Against Ishii et al under 35 USC § 102

12. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground by indicating that specifying in the claims that the acetic anhydride reactant consists essentially of

Art Unit: 1623

acetic anhydride excludes polybasic acids such as the dibasic and tribasic acids of the Ishii et al patent. This argument is not persuasive since reference to the acetic anhydride reactant consisting essentially of acetic anhydride refers to a process limitation. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Applicants further argue that improved releasability of the cellulose triacetate dopes of the present invention is not predicable from Ishii et al. This argument is not persuasive since Claims 1 and 4-10 are drawn to cellulose triacetate compounds, not releasability of cellulose triacetate dopes. As indicated above, a difference in intended use cannot render a claimed composition novel. Accordingly, the rejection of Claims 1 and 4-10 under 35 U.S.C. 102(b) as being anticipated by the Ishii et al patent is maintained for the reasons of record.

13. Claims 18, 20 and 23 stand rejected under 35 U.S.C. 102(b) as being anticipated by Takeda et al (US Patent No. 5,152,974) for the reasons set forth on pages 5 and 6 of the Office Action mailed April 28, 2003.

Response to Arguments Against Takeda et al under 35 USC § 102

14. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Takeda et al patent is silent on the role of a free carboxyl groups in cellulose triacetate. This argument is not persuasive since the presence of a free carboxyl group is only one of the features optionally required for the instantly claimed cellulose triacetate compound. Features (ii) and (iii) are limited to process conditions and do not state how or where on the cellulose triacetate compound is the acid, alkali metal or alkaline earth metal attached to the cellulose triacetate compound. It is known in this art that acetic acid is present in the reaction medium during preparation of cellulose triacetate and acetic acid falls within the group consisting of an acid having an acid dissociation

Art Unit: 1623

exponent pKa of 1.93 to 4.50 set forth in feature (ii) of instant Claim 1. Process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Arguments directed to unexpected advantages and commercial success to show differences between the cellulose triacetate of the instant claims and the cellulose triacetate of the Takeda et al patent are noted. However, Applicants are reminded that a difference in intended use cannot render a claimed composition novel. Note *In re Tuominen*, 213 USPQ 89 (CCPA, 1982); *In re Pearson*, 494 F2d 1399; 181 USPQ 641 (CCPA, 1974); and *In re Hack* 114 USPQ 161. Accordingly, the rejection of Claims 18, 20 and 23 under 35 U.S.C. 102(b) as being anticipated by the Takeda et al patent is maintained for the reasons of record.

Claim Rejections - 35 USC § 103

15. Claims 1-13, 15, and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Finlayson (GB Patent No. 1,102,976) for the reasons set forth on pages 6 and 7 of the Office Action mailed April 28, 2003.

Response to Arguments Against Finlayson under 35 USC § 103

16. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Finlayson patent is silent on the role of a free carboxyl groups in cellulose triacetate. This argument is not persuasive since the presence of a free carboxyl group is only one of the features required for the instantly claimed cellulose triacetate compound. Features (ii) and (iii) are limited to process conditions. See page 2, 1st column, lines 7 and 34 of the Finlayson patent wherein perchloric acid and acetic acid may be present with the cellulose triacetate which are acids that fall within the group consisting of an acid having an acid dissociation exponent pKa of 1.93 to 4.50 set forth in feature (ii) of instant Claim 1. Process limitations cannot impart patentability to a product that is not

Art Unit: 1623

patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981.

Arguments directed to unexpected advantages and commercial success to show differences between the cellulose triacetate of the instant claims and the cellulose triacetate of the Finlayson patent are noted. However, Applicants are reminded that a difference in intended use cannot render a claimed composition novel. Note *In re Tuominen*, 213 USPQ 89 (CCPA, 1982); *In re Pearson*, 494 F2d 1399; 181 USPQ 641 (CCPA, 1974); and *In re Hack* 114 USPQ 161. Accordingly, the rejection of Claims 1-13, 15, and 16 under 35 U.S.C. 103(a) as being unpatentable over the Finlayson patent is maintained for the reasons of record.

17. Claims 17 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al (US Patent No. 3,816,150) in view of Malm (US Patent No. 2,582,049) for the reasons set forth on pages 7 and 8 of the Office Action mailed April 28, 2003.

Response to Arguments Against Finlayson under 35 USC § 103

18. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground by indicating that specifying in the claims that the acetic anhydride reactant consists essentially of acetic anhydride excludes polybasic acids such as the dibasic and tribasic acids of the Ishii et al patent. This argument is not persuasive since reference to the acetic anhydride reactant consisting essentially of acetic anhydride refers to a process limitation. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. The Malm et al patent is only cited to show that the use of reactants comprising cellulose, acetic acid, acetic anhydride, and sulfuric acid catalyst

to produce cellulose triacetate is well known in the art. Accordingly, the rejection of Claims 17 and 22 under 35 U.S.C. 103(a) as being unpatentable over the Ishii et al patent in view of the Malm patent is maintained for the reasons of record.

Election/Restrictions

19. This application contains Claims 24 and 25 drawn to an invention nonelected with traverse in Paper No. 39. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Summary

20. All the claims are rejected.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information

22. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Art Unit: 1623


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



E. White



James O. Wilson
Supervisory Primary Examiner
Technology Center 1600